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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,990	01/31/2002	Stanley Eugene McDaniel	10017918-1	2853

7590 12/08/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

KANG, ROBERT N

ART UNIT PAPER NUMBER

2625

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/062,990

Applicant(s)

MCDANIEL ET AL.

Examiner

Robert N. Kang

Art Unit

2625



--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706:07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



KING Y. POON

PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

Response to Arguments

1. Objection to the title has been removed.
2. Applicant's arguments filed 11/29/2006 have been fully considered but they are not persuasive. The individual arguments are listed and refuted below.
 - I. "Wu does not show or suggest forecasting image processing parameters of an image processing operation based upon an image processing setting" (page 15, paragraph 8). The "monitor parameters" of FIG. 2B, C, and D are calculated based upon the "selectable parameters" of FIG. 2A. This relationship was stated clearly in the Office Action, and will be depicted in a table, as the examiner can think of no other method to enhance the clarity of this equivalence.

Applicant's Invention	Equivalent Wu Element
"settings" (input)	"selectable parameters" (input)
"parameters" (output)	"monitor parameters" (output)

Therefore, there is clear and unambiguous "distinction between image processing settings and image processing parameters."

- II. "Official notice is inappropriate" (page 16, paragraph 8). On the contrary, the official notice was utilized *only to meet new limitations added in the amendment after non-final rejection*. Thus, had the applicant appropriately claimed his invention in the first set of claims, a proper reference could have been provided in the Final Rejection. Regardless, a reference is provided below.

III. "Non analgous with respect to the technology" (page 17, paragraph 3).

The Wu reference teaches, among many other things, adjusting the settings of an image capture device and calculating properties of the output. Any individual of normal skill in the art can easily grasp how this teaching may be transferred regardless of the method of image capture. The invention claims "an image processing evaluation method," furthermore, the novelty and heart of the invention is in the selection of settings and the evaluation of "parameters." One of ordinary skill would have reasonably consulted Wu's image processing evaluation method in seeking a solution to the problem addressed by the instant invention.

IV. "Teaches away" (page 18, paragraph 4). Wu discloses a self-contained MRI machine. However, he never indicates that an MRI *cannot* consist of separate imaging components. In fact, there are several MRI devices wherein a computer is connected to the actual scanning hardware allowing the user to control the device remotely. Nor does Wu ever indicate or imply that his user interface and monitor parameter calculation method is to be strictly implemented in a single unit. Thus, there is no "teaching away."

VI. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction

Art Unit: 2625

based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Examiner's Official Notice:

Yamaguchi (US 2001/0043758) discloses a copy machine, which meets the required limitations, "optically scan[ning] an image from a print medium, copy the image into memory, and/or print the image onto another print medium."

Regarding the Applicant's spurious line of reasoning of page 19, paragraph 1-3, the Examiner disagrees. The applicant has stated that the use of official notice is indicative of hindsight reasoning, and that providing a new reference requires the withdrawal of finality.

The applicant does not challenge the official notice, presenting a seemingly paradoxical situation- without a reference, the rejection is improper use of hindsight reasoning, with a reference, it constitutes a new argument and finality must be withdrawn. Examiner considers the applicant's response a challenge to the examiner's official notice that "copy machines were well-known in the industry at the time of invention. Copy machines optically scan an image from a print medium, copy the image into memory, and/or print the image onto another print medium." The Yamaguchi reference, filed 8/3/01, solidifies this assertion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is 571-272-0593. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert N. Kang